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WYETH LLC
PATENT LAW GROUP
5 GIRALDA FARMS
MADISON, NJ 07940

EXAMINER

RAMACHANDRAN, UMAMAHESWARI

ART UNIT	PAPER NUMBER
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1627

NOTIFICATION DATE	DELIVERY MODE
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05/26/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/721,629	Applicant(s) RUDOLPH ET AL.	
	Examiner UMAMAHESWARI RAMACHANDRAN	Art Unit 1627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/17/2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The examiner notes the receipt of the arguments and remarks received in the office on 2/17/2010. Claims 1-14 are pending, claim 8 is withdrawn. Claims 1-7, 9-14 are being examined on the merits herein.

Response to Remarks

Applicants acknowledge the double patenting rejections and state that a terminal disclaimer may be used to overcome the rejections upon finding that other rejections have been overcome. Accordingly, the ODP rejections are maintained. Applicants' arguments regarding the 112(1) and 103(a) rejections have been fully considered and found not to be persuasive. Applicant's arguments are addressed below in the section 'Response to Arguments'. The rejections are maintained and are given below for Applicants' convenience. Accordingly, the action is made Final.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4, 7, 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 30 of U.S. Patent No.7,001,920.

The instant application teaches a method of treating bulimia comprising administering a compound (from a genus) or a pharmaceutically acceptable salt thereof including desmethyl venlafaxine and venlafaxine.

The patent application teaches a method of treating a patient suffering from a condition such as bulimia nervosa administering an effect amount of O-desmethylvenlafaxine formate. The patent also teaches that O-desmethylvenlafaxine is a major metabolite of venlafaxine (col. 1, lines 1-2).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent and the present application teach a method of treatment of bulimia nervosa administering a compound of formula as exemplified in claim 1 of the instant application.

Hence the claims 1, 2, 4, 7, 11 of the present application are an obvious variation of the patent.

Claims 1, 2, 4, 7, 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 41 of U.S. Patent No. 6,673,838.

The instant application teaches a method of treating bulimia comprising administering a compound (from a genus) or a pharmaceutically acceptable salt thereof including desmethyl venlafaxine and venlafaxine.

The patent application teaches a method of treating a patient suffering from a condition such as bulimia nervosa administering an effect amount of O-

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desmethylvenlafaxine formate. The patent also teaches that O-desmethylvenlafaxine is a major metabolite of venlafaxine (col. 1, lines 17-18).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent and the present application teach a method of treatment of bulimia nervosa administering a compound of formula as exemplified in claim 1 of the instant application.

Hence the claims 1, 2, 4, 7, 11 of the present application are an obvious variation of the patent.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7, 9-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims are directed to a method of treating bulimia nervosa in a mammal comprising administering an effective amount of a compound as claimed in the instant invention. While, the specification teaches a method of the treatment of obesity administering venlafaxine, the specification does not teach a method of treatment of bulimia administering any of the compounds claimed including the elected species venlafaxine. The prior art teaches administration of antidepressant compounds in a

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method of treating bulimia. The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

(1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary.

(1) The nature of the invention/ (2) Breadth of the claims:

All of the rejected claims are drawn to a method of treating bulimia nervosa in a mammal comprising administering an effective amount of a compound as claimed in the instant invention. The claims are broad with respect to the number of compounds claimed.

(3) Guidance of the Specification:

Applicants have provided guidance in the specification for treatment of obesity comprising administering venlafaxine. The guidance given by the specification for a

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therapeutic method of treating bulimia nervosa comprising administering to a mammal an effective amount of a compound of the formula as shown in claims 1 or 4 is none.

(4) Working Examples:

The specification provides examples for the treatment of obesity comprising administering venlafaxine.

(5) The relative skill of those in the art:

The relative skill of those in the medical treatment art is high, requiring advanced education and training.

(6) The predictability of art:

Despite the advanced training in the medical treatment arts, the arts are highly unpredictable. The state of the art is such that it is not possible to predict the activity of a compound, whether in vitro or in vivo, based on the structure alone. In order to predict the in vivo activity of a compound based on the in vitro assay, the assay itself must be definitively well correlated to the pathophysiology of a target disease and verified as being predictive of the in vivo activity of a compound. For example, if a receptor is known to be overactivated in the pathophysiology of a disease, the ordinary practitioner would predict that a compound that inhibits the activation of the receptor may be useful for the treatment of said disease. However, even for in vitro models that involve receptors known to be involved in the pathophysiology of a disease, translating the in vitro efficacy of the compound to in vivo efficacy for the treatment of a disease is notoriously unpredictable unless the correlation has been conclusively verified. Further, the in vivo efficacy of a compound is not only determined by the affinity or activity of the

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compound on its target receptor in a validated in vitro assay, but by a range of other factors including the bioavailability of the compound, its pharmacokinetic profile, and the specificity of the compound for the desired target versus other potential targets.

Applicants' teach in the specification that obesity and bulimia nervosa are different disorders (p 2, lines 10-18). Hence it is not predictable from the experiments of treatment of obesity that a disorder such as bulimia nervosa is treated.

(7) The state of the art:

Pope et al. (J Clin Psychiatry, July 1985, 339-3450) teaches administration of antidepressants and the therapeutic benefits of all kinds of antidepressants in bulimic patients. Schweizer et al. (J of Clin. Psychopharmacology, 1991, 233-36).and Edgren et al. (US 6,440,457) teaches venlafaxine as an antidepressant. It is known in the art that the dosage of fluoxetine which has been shown to be useful in treating bulimia and depression vary depending on the disorder. For example, the document (<http://depression.emedtv.com/prozac/prozac-dosage.html>) teaches the dosage of prozac for bulimia treatment starts with 60 mg once a day and for depression or obsessive compulsive disorder it is 20 mg once daily.

(7) The Quantity of Experimentation Necessary:

In order to practice the above claimed invention, one of ordinary skill in the art would have to first envision formulation, dosage, duration, route and, in the case of human treatment, an appropriate animal model system for the claimed compound(s). One would then need to test the compound in the model system to determine whether or not the compound is useful in the treatment of bulimia nervosa. If unsuccessful, which is

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likely given the lack of significant guidance from the specification or prior art regarding the therapeutic method of treating bulimia nervosa comprising administering the claimed compounds, one of ordinary skill in the art would have to envision a modification in the formulation, dosage, duration, route of administration etc. and appropriate animal model system, or envision an entirely new combination of the above and test the system again. In order to practice the applicant's invention, it would be necessary for one to conduct the preceding experimentation for each compound listed in claims 1 and 4 for the treatment of bulimia nervosa. It is known in the art that the dosage amount of a drug is different in treating different type of disorders. For example the dosage of prozac for bulimia treatment starts with 60 mg once a day and for depression or obsessive compulsive disorder it is 20 mg once daily. The dosage amount depends on the medical condition treated, severity of the condition, age, weight type of administration, dosage forms, if the patient has any existing condition(s) (e.g. diabetes, hypertension etc), and other medications that the patient may currently be taking. Therefore, it would require undue, unpredictable experimentation to practice the claimed invention of treating bulimia nervosa comprising administering to the mammal an effective amount of compounds of the formula listed in claims 1 and 4. Genetech, 108 F.3d at 1366 states that "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable". Accordingly, the entire scope of the instant claims is not enabled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. (Int J Obs 1987, p 171-7) and Walsh et al. (J of Psychosomatic Research, 1991, p 33-40) in view of Fabre et al. (Curr Therapeutic Res, 42, 5, 1987).

Freeman et al. teaches fluoxetine, an antidepressant (60-80 mg) in treatment of bulimia (see Method, p 173 and Results, p 174). The reference also teaches the therapeutic benefits of other antidepressants such as imipramine, amitriptyline, tricyclics, or phenelzine in treating bulimic patients.

Walsh et al. teaches fluoxetine in the treatment of bulimia nervosa. The reference teaches fluoxetine as an antidepressant and as a serotonin reuptake inhibitor (see Fluoxetine, p 35). The reference also teaches the therapeutic benefits of other

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antidepressants such as imipramine, amitriptyline, tricyclics, or phenelzine in treating bulimic patients.

In summary, the prior art teaches the therapeutic benefits of a serotonin reuptake inhibitor such as fluoxetine, an antidepressant in treating bulimia nervosa.

The references fail to teach a compound of formula in claim 1 such as venlafaxine (elected species) in a method of treating bulimia nervosa.

Fabre et al. teaches that both (-) and (+) enantiomers of Wy-45,030 (venlafaxine), have preclinical antidepressant properties. Furthermore, the reference teaches that the compound prevents the neuronal uptake of serotonin, norepinephrine and dopamine (see, Introduction, para 1-2). The reference teaches oral administration of the drug in dosage ranging from 10 mg to 250 mg.

It would have been obvious to one of ordinary skill in the art at the time of the invention to treat bulimia nervosa by administering a compound such as venlafaxine because of the prior art teachings. Freeman et al. and Walsch teaches the benefits of fluoxetine, an antidepressant and a serotonin reuptake inhibitor in a method of treating bulimia nervosa. It is known from Fabre's teachings that venlafaxine is an antidepressant and blocks neuronal uptake of serotonin. One having ordinary skill in the art at the time of the invention would have been motivated to administer venlafaxine for another antidepressant and a serotonin reuptake inhibitor such as fluoxetine in a method of treatment of bulimia from Freeman and Walsh's teachings in expectation of success, as an alternative therapy and to achieve similar or superior therapeutic benefits compared to fluoxetine. It would have been obvious to one of ordinary skill in

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the art at the time of the invention to prepare and to separate selective stereoisomers of venlafaxine for its use in a method of treatment of bulimia nervosa because Fabre et al. teaches that both (-) and (+) enantiomers of Wy-45,030 (venlafaxine), have preclinical antidepressant properties. The prior art Fabre et al. do not explicitly teach that the dosage form of venlafaxine is in the form of a tablet or a capsule. It is well known in the art that the oral administration dosage forms include tablets and capsules (US 6,440,457). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the compounds of formula of claim 1 as tablets or capsules because oral administration dosage forms include tablets, capsules etc and Edgren in U.S. 6,440,457 teaches the compounds of the instant application is available as tablets and capsules.

Claims 1-5, 7, 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. (Int J Obs 1987, p 171-7) and Walsh et al. (J of Psychosomatic Research, 1991, p 33-40) in view of Edgren et al. (US 6,440,457).

Freeman et al. teaches fluoxetine, an antidepressant (60-80 mg) in treatment of bulimia (see Method, p 173 and Results, p 174). The reference also teaches the therapeutic benefits of other antidepressants such as imipramine, amitriptyline, tricyclics, or phenelzine in treating bulimic patients.

Walsh et al. teaches fluoxetine in the treatment of bulimia nervosa. The reference teaches fluoxetine as an antidepressant and as a serotonin reuptake inhibitor (see Fluoxetine, p 35). The reference also teaches the therapeutic benefits of other

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antidepressants such as imipramine, amitriptyline, tricyclics, or phenelzine in treating bulimic patients.

In summary, the prior art teaches the therapeutic benefits of a serotonin reuptake inhibitor such as fluoxetine, an antidepressant in treating bulimia nervosa.

The references fail to teach a compound of formula in claim 1 such as venlafaxine (elected species) in a method of treating bulimia nervosa.

Edgren et al. teach controlled dosage release forms comprising compounds of the instant application (as claimed in claim 1 and 4 of the instant application) including venlafaxine for antidepressant therapy (col. 1, lines 1-20, col. 6, lines 20-30, example 4). The reference teaches oral administration of such compounds to humans to produce antidepressant therapy (col. 14, claim 1). The reference teaches the antidepressant compounds are in dosage form of 0.5-750 mg of drug (col. 6, lines 41-44). The reference teaches that the conventional dosage forms of the drug of the compounds of the instant application is available as tablets and capsules (col. 2, lines 14-15). The reference teaches that venlafaxine in vitro prevents the neuronal uptake of serotonin, norepinephrine, and dopamine (col. 6, lines 32-33).

It would have been obvious to one of ordinary skill in the art at the time of the invention to treat bulimia nervosa by administering a compound such as venlafaxine because of the prior art teachings. Freeman et al. and Walsch teaches the benefits of fluoxetine, an antidepressant and a serotonin reuptake inhibitor in a method of treating bulimia nervosa. Edgren et al. teach venlafaxine as an effective antidepressant and further teach the compound prevents the neuronal uptake of serotonin, norepinephrine,

and dopamine. One having ordinary skill in the art at the time of the invention would have been motivated to administer venlafaxine for another antidepressant and a serotonin reuptake inhibitor such as fluoxetine in a method of treatment of bulimia from Freeman and Walsh's teachings in expectation of success, as an alternative therapy and to achieve similar or superior therapeutic benefits compared to fluoxetine.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. (Int J Obs 1987, p 171-7) and Walsh et al. (J of Psychosomatic Research, 1991, p 33-40) in view of Edgren et al. (US 6,440,457) as applied to claims 1-5, 7, 9-14 above and further in view of Fabre et al. (Curr Therapeutic Res, 42, 5, 1987).

Freeman, Walsh and Edgren et al. teachings discussed as above.

The references do not teach the substituents R5 and R6 are both in the meta position or one of R5 or R6 is in the para position.

Freeman et al. teaches fluoxetine, an antidepressant (60-80 mg) in treatment of bulimia (see Method, p 173 and Results, p 174). The reference also teaches the therapeutic benefits of other antidepressants such as imipramine, amitriptyline, tricyclics, or phenelzine in treating bulimic patients.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare and to separate selective stereoisomers of venlafaxine for its use in a method of treatment of bulimia nervosa because Fabre et al. teaches that both (-) and (+) enantiomers of Wy-45,030 (venlafaxine), have preclinical antidepressant properties.

Response to Arguments

(1) 112(1) rejection:

Applicants' argument regarding the 112(1) rejection has been fully considered and found not to be persuasive. Applicants argue that one skilled in the art, with Applicants disclosure before him or her, would be able to practice the claimed invention without undue experimentation and U.S. Patent No. 4,535,186 (Husbands et al.), which discloses (see column 1) that the compounds of the presently claimed formula, substituted phenethylamine derivatives, are central nervous system antidepressants and as described in the present specification (page 8, lines 21-24), the administered dosages of venlafaxine were well within the dosage range prescribed for the use of venlafaxine to treat depression.

In response, Applicants have shown studies for treating obesity with venlafaxine at an initial dose of 25 mg and the dose was increased from 50 mg/day to 150 mg/day (through study day 14) and on study day 15 the dose was increased to 225 mg/day and the dose was continued for the remainder of the 70 day study (Specification, p 8). The dosage regimen used in obesity treatment has varied in the study. Applicants have shown this for just one compound venlafaxine in treating obesity but have claimed venlafaxine and compounds with varying substituents for treating bulimia nervosa. It is known in the prior art that different classes of antidepressants (tricyclic, serotonin reuptake inhibitors) have been shown in the art (See Freeman et al, Walsh et al, above) to treat bulimia. However the dosage amount that is useful in treating a depressive disorder may not be the same as for treating bulimia. For example, as shown in Prozac

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document (<http://depression.emedtv.com/prozac/prozac-dosage.html>), the dosage of prozac for bulimia treatment starts with 60 mg once a day and for depression or obsessive compulsive disorder it is 20 mg once daily. It is known in the art that a representative compound of formula I, namely venlafaxine (elected species) is known in the art to treat depression and the dosage amount ranges from 10-250 mg (see Edgren et al., above), The dosage used in obesity study by the Applicants varies from the dosage for depression treatment and also with the dosage regimen. As it is evidenced from the study of the Applicants' the dosage for just one compound venlafaxine varied on different stages of the obesity study. Bulimia Nervosa is characterized by recurrent binge eating in which the individual feels a loss of control over eating and regularly practices rigorous dieting or fasting, or purging by self-induced vomiting, or the use of diuretics, or laxatives in an attempt to overcome the feeling. Obesity is characterized by excess proportion of body fat. The results done for obesity study cannot be translated to bulimia study because bulimia and obesity are two different disorders. Hence it would be an undue experimentation for a person of ordinary skill in the art to determine the dose factors for all the compounds of formula of claim 1 and to determine the dosage regimens based on various factors that include age, weight, existing medical conditions, medications that patients are currently taking, dosage forms etc. Accordingly, the entire scope the claims is not enabled.

(2) 103(a) rejections:

Applicants argue that Freeman and Walsh references do not provide reasonable expectation of success of the claimed method or provide motivation to administer an

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antidepressant other than fluoxetine for treating bulimia. In response, Freeman teaches that out of ten subjects treated with fluoxetine, seven stopped their bulimic behavior completely, two improved and one unchanged. Hence Freeman's study on bulimia with fluoxetine shows success in treating the disorder in at least 9 out of ten patients.

Furthermore the reference teaches other antidepressants and hence teaches that antidepressants are useful in treating bulimia disorder. Walsh teaches the use of antidepressants in bulimia and specifically fluoxetine in bulimic treatment. Fabre has been cited to show that venlafaxine (WY-45,030) and its enantiomers as antidepressant compounds. Hence it would have been obvious to a person of ordinary skill in the art at the time of the invention to have used venlafaxine in a method of treating bulimia. A person of ordinary skill in the art at the time of the invention would have been motivated to use one antidepressant (here venlafaxine) for another antidepressant such as fluoxetine to treat bulimia in expectation of similar or better therapeutic benefits.

Applicants' argue that Fabre et al. teaches venlafaxine and its enantiomers and state that this "new compound may have antidepressant activity in humans". In response, Fabre in the abstract, lines 1-2 teaches that Wy-45,030 (venlafaxine) as a bicyclic antidepressant and in p 901, para1, teaches that "Both the (+) and (-) enantiomers of Wy-45,030 have preclinical antidepressant properties. Hence the reference teaches the compound venlafaxine as an antidepressant. Also, applicants argue that the teachings of Fabre et al. do not overcome the deficiencies of Freeman et al. and Walsh. In response, Fabre has been cited to show that venlafaxine compound is an antidepressant. Hence as stated above, it would have been obvious to a person of

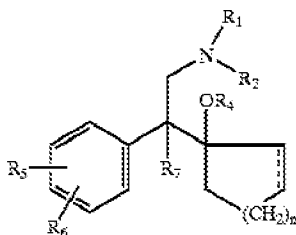
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ordinary skill in the art to try using venlafaxine in treating bulimia from the combined studies of Freeman, Walsh and Fabre. In addition the reference states that the compound is safe and well tolerated. This provides additional motivation for a person of ordinary skill in the art to try venlafaxine in treating bulimic disorder in humans.

Applicants' argue that the teachings of Edgren et al. do not overcome the deficiencies of Freeman et al. and Walsh. In response, Edgren teaches the process of manufacture of a composition comprising venlafaxine (example 1). The reference further teaches the genus of compounds including venlafaxine and its use in antidepressant therapy. In addition the reference teaches making formulation of venlafaxine. The reference was used to show that venlafaxine can be useful in an antidepressant therapy. It would have been obvious to a person of ordinary skill in the art to try using venlafaxine in treating bulimia from the combined studies of Freeman, Walsh and Edgren.

Applicants' argue that none of the compounds in Fabre have substituents in meta position and do not teach or suggest the use of venlafaxine stereoisomers. In response, Fabre teaches the enantiomers of venlafaxine as having antidepressant activity and Edgren teaches the compound venlafaxine including its stereoisomers. Edgren teaches the following compounds and in col. 6, lines 1-10 teaches that R5 and R6 are independently a member selected from the

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group consisting of hydrogen, hydroxyl, an alkyl of 1 to 6 carbon atoms, an alkoxy of 1 to 6 carbon atoms, alkanoyloxy of 2 to 7 carbon atoms, nitro, alkylmercapto of 1 to 6 carbon atoms, amino, alkylamino of 1 to 6 carbon atoms in which each alkyl group comprises 1 to 6 carbon atoms as claimed by the Applicants. Also, compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). See also *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (stereoisomers *prima facie* obvious). Hence it would have been obvious to a person of ordinary skill in the art at the time of the invention to have used stereoisomers of venlafaxine in a method of treating bulimia in view of the combined teachings of Freeman, Walsh, Edgren and Fabre.

Conclusion

No claims are allowed.

The rejections from the previous office action have been maintained.

Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umamaheswari Ramachandran whose telephone number is 571-272-9926. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1627